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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,789	09/23/2004	Takashi Nakanishi	2004_1419A	3937
513 7590 09/23/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER KAU, STEVEN Y				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/508,789

Applicant(s)

NAKANISHI ET AL.

Examiner

STEVEN KAU

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-74 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
2. Sub-combination of communication apparatus:
 - I. Claims 1-23 are to a communication apparatus that is used by being connected to a printing apparatus and a consumable's order receiving apparatus for receiving an order for a consumable used by the printing apparatus, comprising a content obtaining unit, a print control unit and an ordering unit. Claims 1-23 are classified in class 705, subclass 52.
 - II. Claims 22 and 71 are drawn to a communication apparatus that is used by being connected to a content providing apparatus and a printing apparatus, comprising a receiving unit, a print control unit and an ordering unit. Claims 22 and 71 are classified in class 705, subclass 52.
 - III. Claims 24-29, 30 and 34 are drawn to a communication apparatus that is used by being connected to a printing apparatus and a service processing apparatus for receiving a service to be provided for the printing apparatus, comprising a user information obtaining unit and a service transmitting unit. Claims 24-29, 30 and 34 are classified in Class 705, subclass 18.

IV. Claims 31-33 are drawn to a communication apparatus that is connected to a printing apparatus, comprising a receiving unit and a display unit. Claims 31-33 are classified in Class 705, subclass 411.

3. Sub-combination of printing apparatus:

V. Claims 35-48 and 65 are drawn to a printing apparatus, comprising a printing unit, consumable information generating unit and a transmitting unit. Claims 25-48 and 65 are classified in Class 358, subclass 1.15.

VI. Claims 49-55 and 72 are drawn to a printing apparatus, comprising a printing unit, maintenance information generating unit and a transmitting unit. Claims 25-48 and 65 are classified in Class 358, subclass 1.15.

VII. Claims 56-62 and 73 are drawn to a print apparatus, comprising a printing unit, service information generating unit, a device specific information keeping unit and a transmitting unit. Claims 25-48 and 65 are classified in Class 358, subclass 1.15.

VIII. Claims 63-64 and 74 are drawn to a printing apparatus, comprising a printing unit, a detecting unit, a service information generating unit, a response information generating unit and a transmitting unit. Claims 25-48 and 65 are classified in Class 358, subclass 1.15.

4. Sub-combination of consumable's order receiving apparatus:

IX. Claims 66-69 are drawn to a consumable's order receiving apparatus that is connected, via a transmission line, to a communication apparatus which outputs print data of a print content to a printing apparatus, and receives, from the communication apparatus, an order for a consumable used by the printing apparatus, wherein the communication apparatus comprising a content obtaining unit, a print control unit, an ordering unit; and the consumable's order receiving apparatus comprising an order-receiving unit, a charging processing unit. Claims 66-69 are classified in Class 705, subclass 77.

X. Claim 70 are drawn to a communication system, comprising a printing apparatus, a communication apparatus for outputting, to the printing apparatus, print data of a print content, and a consumable's order receiving apparatus for receiving an order for a consumable used by the printing apparatus. Claim 70 is classified in Class 705, subclass 77.

Invention in sub-combination of communication apparatus, sub-combination of printing apparatus and sub-combination of consumable's order receiving apparatus are related as subcombinations usable together in one combination of print content distribution system in a network. The subcombinations are distinct if they do not

overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. For example, the instant case subcombination of communication apparatus Group I (Claims 1-23) has a separate utility, e.g. a communication apparatus comprising a content obtaining unit, a print control unit and an ordering unit. On the other hand, the instant subcombination of printing apparatus Group V (Claims 35-48 and 65) has a separate utility, e.g. a printing device comprising a printing unit, a consumable information generating unit and a transmitting unit. And the instant case consumable's order receiving apparatus Group IX (Claims 66-69) has a separate utility, e.g. a communication apparatus comprising an order-receiving unit, a charging processing unit, which is distinct with Group I (Claims 1-23) and Group V (Claims 35-48 and 65). See MPEP § 806.05(d).

In the instant case, the subcombinations in Groups I to IV (Claims 1-23, Claims 22 and 71, Claims 24-29, 30 and 34, and Claims 31-33) as claimed does not require the particulars of the subcombinations in Groups V-VIII (Claims 35-48 and 65, 49-55 and 72, Claims 56-62 and 73, and Claims 63-64 and 74), or the subcombinations in Groups IX and X (Claims 66-69 and Claim 70) as claimed for patentability, because: the specific in the subcombinations in Groups I to IV, for instance, claim 1 recites, a content obtaining unit, a print control unit and an ordering unit, is particular which is not required in the subcombinations in Groups V-VIII, or subcombinations in Groups IX and X for patentability.

In addition, groups in each sub-combination are drawn to different species.

With respect to sub-combination of communication apparatus, different species are drawn:

I. Claims 1-23 are to a communication apparatus that is used by being connected to a printing apparatus and a consumable's order receiving apparatus for receiving an order for a consumable used by the printing apparatus, comprising a content obtaining unit, a print control unit and an ordering unit. Species of the embodiment disclosed in Paragraph 10, US Publication US 2005/0147440.

II. Claims 22 and 71 are drawn to a communication apparatus that is used by being connected to a content providing apparatus and a printing apparatus, comprising a receiving unit, a print control unit and an ordering unit. Species of the embodiment disclosed in Paragraph 21, US Publication US 2005/0147440.

III. Claims 24-29, 30 and 34 are drawn to a communication apparatus that is used by being connected to a printing apparatus and a service processing apparatus for receiving a service to be provided for the printing apparatus, comprising a user information obtaining unit and a service transmitting unit. Species of the embodiment disclosed in Paragraph 17, US Publication US 2005/0147440.

IV. Claims 31-33 are drawn to a communication apparatus that is connected to a printing apparatus, comprising a receiving unit and a display unit. Species of the embodiment disclosed in Paragraph 21, US Publication US 2005/0147440.

With respect to sub-combination of printing apparatus, different species are drawn:

V. Claims 35-48 and 65 are drawn to a printing apparatus, comprising a printing unit, consumable information generating unit and a transmitting unit. Species of the embodiment disclosed in Paragraph 22, US Publication US 2005/0147440.

VI. Claims 49-55 and 72 are drawn to a printing apparatus, comprising a printing unit, maintenance information generating unit and a transmitting unit. Species of the embodiment disclosed in Paragraph 24, US Publication US 2005/0147440.

VII. Claims 56-62 and 73 are drawn to a print apparatus, comprising a printing unit, service information generating unit, a device specific information keeping unit and a transmitting unit. Species of the embodiment disclosed in Paragraph 93, US Publication US 2005/0147440.

VIII. Claims 63-64 and 74 are drawn to a printing apparatus, comprising a printing unit, a detecting unit, a service information generating unit, a response information generating unit and a transmitting unit. Species of the embodiment disclosed in Figure 12, and Paragraph 129, US Publication US 2005/0147440.

With respect to sub-combination of consumable's order receiving apparatus, different species are drawn:

IX. Claims 66-69 are drawn to a consumable's order receiving apparatus that is connected, via a transmission line, to a communication apparatus which outputs print data of a print content to a printing apparatus, and receives, from the communication apparatus, an order for a consumable used by the printing apparatus, wherein the communication apparatus comprising a content obtaining unit, a print control unit, an ordering unit; and the consumable's order receiving apparatus comprising an order-receiving unit, a charging processing unit. Species of the embodiment disclosed in Paragraph 30, US Publication US 2005/0147440.

X. Claim 70 are drawn to a communication system, comprising a printing apparatus, a communication apparatus for outputting, to the printing apparatus, print data of a print content, and a consumable's order

receiving apparatus for receiving an order for a consumable used by the printing apparatus. Species of the embodiment disclosed in Figure 1, and Paragraph 53, US Publication US 2005/0147440.

Restriction for examination purpose as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious burden and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the invention has acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their divergent subject matter;

(c) the inventions require a different field of search (for example, searching different class/subclass or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C 112, first paragraph.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the restriction may be

traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out the supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

Shall applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence of admission may be used in a rejection under 35 U.S.C 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120

and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/
Examiner, Art Unit 2625
9/18/2008

/King Y. Poon/
Supervisory Patent Examiner, Art Unit
2625